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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,668	02/01/2002	Sarah Laskoski	202-0094 RLC	1460
22844 7590 07/10/2007 FORD GLOBAL TECHNOLOGIES, LLC FAIRLANE PLAZA SOUTH, SUITE 800 330 TOWN CENTER DRIVE DEARBORN, MI 48126			EXAMINER VAN DOREN, BETH	
			ART UNIT 3623	PAPER NUMBER
			MAIL DATE 07/10/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/683,668

**Applicant(s)**

LASKOSKI, SARAH

**Examiner**

Beth Van Doren

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following is a Final office action in response to communications received 01/05/2007. Claims 1-3, 6, 9, 11-12, 15, 17, 19, 23, 26-32, 35, and 39 have been amended. Claims 1-42 are pending.

#### ***Response to Amendment***

2. Applicant's amendment to claim 11 is sufficient to overcome the 35 USC 112, second paragraph, rejections set forth in the previous office action.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2-3, 9-11, 13-18, 26-28, 31, and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nutter et al. (U.S. 2002/0178029).

As per claim 1, Nutter et al. teaches a tool to prioritize opportunities by assigning a relative calculated value to every opportunity, the tool comprising:

A plurality of modules, each of said modules having a plurality of value drivers (See figure 7, paragraphs 0025, 0029, 0039, which discusses the system storing parameters that drive value);

a plurality of user-specified variables in response to the value drivers (See paragraphs 0019, 0022, 0025-6, 0039, which discloses a user inputting variables into the system in response

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to the parameters. See also figure 7, paragraphs 0025, 0029, 0039, which discusses the system storing parameters that drive value);

a plurality of weighting factors, said weighting factor determined by the opportunity being evaluated, wherein a weighting factor is assigned to said plurality of value drivers, to said plurality of user-specified variables, and to each of said modules (See paragraphs 0025, 0027, 0030, 0039, which discloses weighting factors used in the scoring of the value drivers and weighting variables);

a database coupled to the tool that stores data concerning the evaluation (See figures 1 and 2, paragraphs 0021, 0046); and

a processor operative to calculate a score for each of said modules and an opportunity value for each entered opportunity by a pre-determined function using said user-specified variables and to prioritize the calculated opportunity values (See paragraphs 0025, 0027, 0039, wherein a weighted average is calculated. See paragraphs 0019, 0021, 0026, 0028, 0030-1, wherein a function is used to calculate a value based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, Nutter et al. does not expressly disclose storing the calculated opportunity values for each entered opportunity.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

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invention to store the calculated opportunity values (which are manipulated by the computer of Nutter et al.) in the database of the system in order to more easily eliminate intellectual properties from licensing choices by use of the computer. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities.

As per claim 2, Nutter et al. discloses wherein pre-determined weighting factors assigned to each of the plurality of value drivers vary depending upon each opportunity (See paragraphs 0025, 0027, 0030, which discloses weighting factors used in the scoring of the value drivers).

As per claim 3, Nutter et al. teaches wherein the plurality of modules includes a market module having a plurality of value drivers relating to the marketability of the entered opportunity (See figure 7, paragraphs 0028-32 and 0034, wherein the market of the opportunity is considered in the evaluation).

As per claim 9, Nutter et al. teaches wherein the plurality of modules includes an efficiency module having a plurality of value drivers relating to efficiency of the entered opportunity (See figure 7, 13, paragraphs 0025, 0030, 0034, which at least discloses ease of investigation, strength of claims, all of which are directed towards the effectiveness of the opportunity).

As per claim 10, Nutter et al. discloses calculating an opportunity value for each opportunity using a pre-determined function using variables related to various factors (See paragraphs 0019, 0021, 0026, 0028, 0030-1, 0034, wherein a function is used to calculate a value based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, while Nutter et al. teaches a plurality of licensing and market factors, Nutter et al. does not expressly disclose factors relating to value drivers relating to the efficiency of

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employee job, job knowledge, job tasks, and employee-customer relations for the entered opportunity.

Nutter et al. discloses rating a licensing opportunity using a scoring function including factors related to the market and industry in which the opportunity resides. It is well known in the art that when a new product or opportunity is introduced to an organization that employee job, job knowledge, job tasks, and employee-customer relations must be considered to ensure that the organization is capable of handling the new product/opportunity. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors of employee job, job knowledge, job tasks, and employee-customer relations with the factors used in the scoring function of Nutter et al. in order to more efficiently evaluate intellectual properties and eliminate intellectual properties that do not score as well as others based on the same evaluation factors. See paragraph 0019, 0026, of Nutter et al.

As per claim 11, Nutter et al. wherein the plurality of modules includes an impact module having a plurality of value drivers relating to overall impact of the entered opportunity on the licensee product and licensee customers (See paragraph 0034, which discloses considering the impact of the license on the products of the customer using the license).

As per claim 13, Nutter et al. discloses wherein a form is published on an accessible information network and displays at least one of the plurality of value drivers (See paragraphs 0021, 0039, figures 7, 11, wherein a form is accessible via an information network and displays parameters with which the user is able to interact and enter data).

As per claim 14, Nutter et al. teaches wherein the form is operative to submit the plurality of user-specified variables in response to the value drivers for each of the entered opportunity

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(See paragraphs 0021-22, 0025-6, 0039, which discloses a user inputting variables into the system in response to the parameters).

However, Nutter et al. does not expressly disclose submitting the variables to a database.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to store the variables of Nutter et al. in the database of the system in order to more easily eliminate intellectual properties from licensing choices using the computer and the organization provided by the database. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities.

As per claim 15, Nutter et al. teaches wherein the system receives the user-specified variables in response to the value drivers and to use said score for each of said modules to calculate a total score for each of the entered opportunity (See paragraphs 0019, 0022, 0025-8, 0031, 0039, wherein a score and total score is calculated. See also figure 13).

However, Nutter et al. does not expressly disclose a database is operative to store variables.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to store the variables of Nutter et al. in the database of the system in order to more easily eliminate intellectual properties from licensing choices using the computer and the organization provided by the database. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities.

As per claim 16, Nutter et al. teaches wherein the calculated total score is a pre-determined weighted average of the module scores for each of the entered opportunity (See paragraphs 0025, 0027, 0039, wherein a weighted average is calculated).

As per claim 17, Nutter et al. discloses wherein said score for each of said modules is a pre-determined weighted average of the user-specified variables within a module for each of the entered opportunity (See paragraphs 0025, 0027, 0039, wherein a weighted average is calculated).

As per claim 18, Nutter et al. discloses notifying a recipient about the entered opportunity and corresponding total and module scores (See figure 13, paragraphs 0021, 0038, 0041-4, wherein the recipient is notified via output of the total and separate scores).

However, Nutter et al. does not expressly disclose a database operative to notify recipients.

Nutter et al. discloses a database coupled to the tool (and processor), calculating an opportunity value for each entered opportunity using a scoring function, and notifying a recipient via output of the total and separate scores. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Further, it is old and well known to store notification templates linked with data in the



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database. herefore, it would have been obvious to one of ordinary skill in the art at the time of the invention that the database of Nutter et al. would be operative to notify the recipients in order to more easily eliminate intellectual properties from licensing choices using the computer and the organization provided by the database. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities.

Claims 26-28, 31, and 33-38 recite equivalent limitations to claims 1-3, 11, and 13-18, respectively, and are therefore rejected using the same art and rationale relied upon above.

5. Claims 4-8, 19-25, 29-30, 39, and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nutter et al. (U.S. 2002/0178029) in view of Elliott (U.S. 2001/0042034).

As per claims 4-8, Nutter et al. discloses calculating an opportunity value for each opportunity using a pre-determined function using variables related to various factors (See paragraphs 0019, 0021, 0026, 0028, 0030-1, 0034, wherein a function is used to calculate a value based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, while Nutter et al. teaches a plurality of licensing and market factors, Nutter et al. does not expressly disclose ownership of the entered opportunity, available resources to be applied to development, development cost, development time, implementation cost, and implementation time, financial needs, implications, and cost feasibility as the specific factors used.

Elliott discloses:

As per claim 4, value drivers relating to ownership of the entered opportunity (See paragraphs 0020-2, which discloses ownership of the licensing opportunity).

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As per claim 5, value drivers relating to available resources to be applied to development of the entered opportunity (See paragraphs 0009, 0034, 0111, 0155-6, 0163, which discloses development and the money needed for the development).

As per claim 6, a cost module having a plurality of value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity (See paragraphs 0034-5, 0111, 0117-8, 0121-2, which discloses cost consideration).

As per claim 7, value drivers relating to development cost and development time of the entered opportunity (See paragraphs 0009, 0034, 0111, 0149, 0155-6, 0163, which discloses development, the money needed for the development, and the years of development).

As per claim 8, value drivers relating to implementation cost and implementation time of the entered opportunity (See paragraphs 0111, 0150-2, 0155-6, 0157-9, 0163, which discloses manufacturing, materials, and operation costs, as well as years of sales and years of expenses).

Nutter et al. discloses rating a licensing opportunity using a scoring function including factors related to the market and industry in which the opportunity resides. Elliott discloses valuation of intellectual property using factors such as ownership of the entered opportunity, available resources to be applied to development, development cost, development time, implementation cost, and implementation time, financial needs, implications, and cost feasibility. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors of ownership of the entered opportunity, available resources to be applied to development, development cost, development time, implementation cost, and implementation time, financial needs, implications, and cost feasibility with the factors used in the scoring function of Nutter et al. in order to more efficiently evaluate intellectual properties and eliminate

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intellectual properties that do not score as well as others based on the same evaluation factors.

See paragraph 0019, 0026, of Nutter et al.

As per claim 19, Nutter et al. teaches a system to prioritize licensing opportunities by assigning a relative calculated value to every opportunity, said tool comprising:

a plurality of modules each having a plurality of value drivers (See figure 7, paragraphs 0025, 0029, 0039, which discusses the system storing parameters that drive value), said plurality of modules comprising:

a market module having a plurality of value drivers relating to the marketability of the entered opportunity (See figure 7, paragraphs 0028-32 and 0034, wherein the market of the opportunity is considered in the evaluation);

an efficiency module having a plurality of value drivers relating to efficiency of the entered opportunity (See figure 7, 13, paragraphs 0025, 0030, 0034, which at least discloses ease of investigation, strength of claims, all of which are directed towards the effectiveness of the opportunity); and

an impact module having a plurality of value drivers relating to overall impact of the entered opportunity on the licensee product and licensee customers (See paragraph 0034, which discloses considering the impact of the license on the products of the customer using the license);

a plurality of user-specified variables, linked to pre-determined weighting factors, in response to the value drivers (See paragraphs 0019, 0022, 0025-6, 0039, which discloses a user inputting variables into the system in response to the parameters. See paragraphs 0025, 0027, 0030, which discloses weighting factors used in the scoring of the value drivers);

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a predetermined weighting factor linked to each of said modules (See paragraphs 0019, 0022, 0025-6, 0039, which discloses a user inputting variables into the system in response to the parameters. See paragraphs 0025, 0027, 0030, which discloses weighting factors used in the scoring of the value drivers);

a database coupled to the tool that stores data concerning the evaluation (See figures 1 and 2, paragraphs 0021, 0046); and

a processor operative to calculate an opportunity value for each entered opportunity and a score for each of said modules by a pre-determined function using the user-specified variables and prioritizing the calculated opportunity values (See paragraphs 0019, 0021, 0026, 0028, 0030-1, wherein a function is used to calculate a value based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, Nutter et al. does not expressly disclose storing the calculated opportunity values for each entered opportunity or storing the score for each of said modules. Nutter et al. further does not expressly disclose that the plurality of modules includes a cost module having a plurality of value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity.

Elliott discloses value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity (See paragraphs 0034-5, 0111, 0117-8, 0121-2, which discloses cost consideration).

However Elliott does not expressly disclose storing the calculated opportunity values for each entered opportunity.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to store the calculated opportunity values (which are manipulated by the computer of Nutter et al.) and the derived scores in the database of the system in order to more easily eliminate intellectual properties from licensing choices by use of the computer. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities.

Further, Nutter et al. discloses rating a licensing opportunity using a scoring function including factors related to the market and industry in which the opportunity resides. Elliott discloses valuation of intellectual property using factors such as financial needs, implications, and cost feasibility. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors financial needs, implications, and cost feasibility with the factors used in the scoring function of Nutter et al. in order to more efficiently evaluate intellectual properties and eliminate intellectual properties that do not score as well as others based on the same evaluation factors. See paragraph 0019, 0026, of Nutter et al.

Claim 20 recites equivalent limitations to the combination of claims 4 and 5 and is rejected using the same art and rationale relied upon above.

Claim 21 recites equivalent limitations to the combination of claims 7 and 8 and is rejected using the same art and rationale relied upon above.

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Claims 22 and 23 recite equivalent limitations to claims 10 and 12, respectively, and are therefore rejected using the same art and rationale set forth above.

Claim 24 recites equivalent limitations to the combination of claims 13 and 14 and is rejected using the same art and rationale relied upon above.

Claim 25 recites equivalent limitations to the combination of claims 14, 17, and 18 and is rejected using the same art and rationale relied upon above.

Claims 29 and 30 recite equivalent limitations to claims 6 and 9, respectively, and are therefore rejected using the same art and rationale set forth above.

As per claim 39, Nutter et al. discloses a method to prioritize licensing opportunities by assigning a relative calculated value to every opportunity, the method comprising the steps of:

providing a plurality of modules each having a plurality of value drivers (See figure 7, paragraphs 0025, 0029, 0039, which discusses the system storing parameters that drive value), said plurality of modules comprising:

a market module having a plurality of value drivers relating to the marketability of the entered opportunity (See figure 7, paragraphs 0028-32 and 0034, wherein the market of the opportunity is considered in the evaluation);

an efficiency module having a plurality of value drivers relating to efficiency of the entered opportunity (See figure 7, 13, paragraphs 0025, 0030, 0034, which at least discloses ease of investigation, strength of claims, all of which are directed towards the effectiveness of the opportunity);

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an impact module having a plurality of value drivers relating to overall impact of the entered opportunity on the licensee product and licensee customers (See paragraph 0034, which discloses considering the impact of the license on the products of the customer using the license

applying pre-determined weighting factors to each of the plurality of value drivers (See paragraphs 0025, 0027, 0030, which discloses weighting factors used in the scoring of the value drivers);

providing a published form on an accessible information network that displays at least one of the plurality of value drivers (See paragraphs 0021, 0039, figures 7, 11, wherein a form is accessible via an information network and displays parameters with which the user is able to interact and enter data);

providing a plurality of user-specified variables, linked to pre-determined weighting factors, in response to the value drivers (See paragraphs 0019, 0022, 0025-6, 0039, which discloses a user inputting variables into the system in response to the parameters. See paragraphs 0025, 0027, 0030, which discloses weighting factors used in the scoring of the value drivers);

calculating a total score and module scores for each entered opportunity by a pre-determined function using the user-specified variables (See paragraphs 0019, 0021, 0026, 0028, 0030-1, wherein a function is used to calculate a score value based on the input variables);

a database coupled to the tool that stores data concerning the evaluation (See figures 1 and 2, paragraphs 0021, 0046); and

notifying a recipient about the entered opportunity and corresponding total and module scores (See figure 13, paragraphs 0021, 0038, 0041-4, wherein the recipient is notified via output of the total and separate scores); and

prioritizing the calculated opportunity values (See paragraphs 0019, 0021, 0026, 0028, 0030-1, wherein a scores and data are used to rank, sort, and/prioritize).

However, Nutter et al. does not expressly disclose storing the calculated opportunity values for each entered opportunity. Nutter et al. further does not expressly disclose that the plurality of modules includes a cost module having a plurality of value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity.

Elliott discloses value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity (See paragraphs 0034-5, 0111, 0117-8, 0121-2, which discloses cost consideration).

However Elliott does not expressly disclose storing the calculated opportunity values for each entered opportunity.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to store the calculated opportunity values (which are manipulated by the computer of Nutter et al.) in the database of the system in order to more easily eliminate intellectual properties from licensing choices by use of the computer. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities. Further, Nutter et al. discloses rating a licensing opportunity using a scoring function including factors related to the market and industry in which the opportunity resides. Elliott discloses



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valuation of intellectual property using factors such as financial needs, implications, and cost feasibility. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors financial needs, implications, and cost feasibility with the factors used in the scoring function of Nutter et al. in order to more efficiently evaluate intellectual properties and eliminate intellectual properties that do not score as well as others based on the same evaluation factors. See paragraph 0019, 0026, of Nutter et al.

As per claim 41, Nutter et al. teaches wherein the published form is network enabled form that displays at least one of the plurality of value drivers and is operative to receive the plurality of user-specified variables in response to the value drivers (See paragraphs 0021, 0039, figures 7, 11, wherein a form is accessible via an information network and displays parameters with which the user is able to interact and enter data. See also paragraphs 0025-6. A user inputs variables into the system in response to the parameters).

However, Nutter et al. does not expressly disclose submitting the variables to a database or that the form is web enabled and multi-layered.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Nutter et al. further discloses an automated form that is network enabled and also for the collection of input data. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Also, the web is a well known network in the art allowing for more efficient connections with remote locations. Finally, it is old and well known in the art to use layering in programming for better organization by separating functional components that

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interact in some sequential and hierarchical way. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to store the variables of Nutter et al. in the database of the system in order to more easily eliminate intellectual properties from licensing choices using the computer and the organization provided by the database. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the web and layering in the form of Nutter et al. in order to more efficiently implement the system of Nutter et al. by using well known computing means that allow for better efficiency in communications.

Claim 42 recites equivalent limitations to the combination of claims 14, 17, and 18, and is therefore rejected using the same art and rationale set forth above.

6. Claims 12 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nutter et al. (U.S. 2002/0178029) in view of Wilkinson et al. (U.S. 2002/0099637).

As per claim 12, Nutter et al. discloses calculating an opportunity value for each opportunity using a pre-determined function using variables related to various factors (See paragraphs 0019, 0021, 0026, 0028, 0030-1, 0034, wherein a function is used to calculate a value based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, while Nutter et al. teaches a plurality of licensing and market factors, Nutter et al. does not expressly disclose spin-off ideas, development challenges, and deficiencies as specific factors used.

Wilkinson et al. discloses a plurality of value drivers relating to spin-off ideas, development challenges, and deficiencies of the entered opportunity (See paragraphs 0019-20, 0028-9, 0037, 0054).

Nutter et al. discloses rating a licensing opportunity using a scoring function including factors related to the market and industry in which the opportunity resides. Wilkinson et al. discloses valuation of intellectual property using factors such as spin-off ideas, development challenges, and deficiencies. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors of spin-off ideas, development challenges, and deficiencies with the factors used in the scoring function of Nutter et al. in order to more efficiently evaluate intellectual properties and eliminate intellectual properties that do not score as well as others based on the same evaluation factors. See paragraph 0019, 0026, of Nutter et al.

Claim 32 recites equivalent limitations to claim 12, and is therefore rejected using the same art and rationale set forth above.

7. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nutter et al. (U.S. 2002/0178029) in view of Elliott (U.S. 2001/0042034) and in further view of Wilkinson et al. (U.S. 2002/0099637).

As per claim 40, neither Elliot of Nutter et al. disclose a plurality of value drivers relating to spin-off ideas, development challenges, and deficiencies of the entered opportunity.

Wilkinson et al. discloses a plurality of value drivers relating to spin-off ideas, development challenges, and deficiencies of the entered opportunity (See paragraphs 0019-20, 0028-9, 0037, 0054).

Nutter et al. and Elliot both disclose valuing an intellectual asset based on various factors, the factors used in scoring the opportunities. Wilkinson et al. also discloses valuation of intellectual property using factors such as spin-off ideas, development challenges, and deficiencies. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors of spin-off ideas, development challenges, and deficiencies with the factors used in the scoring function of Nutter et al., along with the other factors disclosed by Elliot, in order to more efficiently evaluate intellectual properties and eliminate intellectual properties that do not score as well as others based on the same evaluation factors. See paragraph 0019, 0026, of Nutter et al.

### ***Response to Arguments***

8. Applicant's arguments with regards to Nutter et al. (U.S. 2002/0178029) have been fully considered, but they are not persuasive. In the remarks, Applicant argues that Nutter et al. does not teach or suggest (1) a plurality of modules and calculating a score for each module, (2) pre-determined weighting factors assigned to each of the plurality of value drivers depending upon the selected opportunity (claim 2), (3) a market module as one of the plurality of modules (claim 3), (4) assigning a calculated value to an entered opportunity and prioritizing the value of each opportunity (claim 10), (5) the impact module having value drivers relating to the overall impact of the entered opportunity on a licensee product and a licensee customer (claim 11), (6)

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calculating a score for each module and using each of the module scores to calculate a total score (claim 15).

In response to argument (1), Examiner respectfully disagrees. Nutter et al. discloses inputting information for different components/measurements of value. See figure 7, paragraphs 0025, 0029, 0039, which discusses the system storing parameters that drive value. A weighted average is calculated by determining a score for each value using an input and a weight. See also paragraphs 0019, 0021, 0026, 0028, 0030-1, wherein a function is used to calculate a value based on the input variables by the user and the values are ranked, sorted, and/or prioritized.

In response to argument (2), Examiner respectfully disagrees. See figure 7, paragraphs 0025, 0027, 0030, 0039, which discloses weighting factors assigned to each of the value drivers that are used in the scoring. These values are predetermined and stored in the system – see specifically figure 7 and 9 and paragraph 0039.

In response to argument (3), Examiner respectfully disagrees. See figure 7, paragraphs 0028-32 and 0034, wherein the market of the opportunity is considered in the evaluation. Examiner notes that a module is merely a component or section in the broadest reasonable interpretation of the claims and, therefore, if something more specific is meant by this term, it should be recited in the claims.

In response to argument (4), Examiner respectfully disagrees. An opportunity value is calculated for each opportunity using a pre-determined function and variables related to various factors. See paragraphs 0019, 0021, 0026, 0028, 0030-1, 0034. These values are used to prioritize the opportunities, such as by considering a priority factor.

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In response to argument (5), Examiner respectfully disagrees. See paragraph 0034, which discloses considering the impact of the license on the products of the customer using the license. Therefore, value drivers are considering that include how the opportunity would be affected by a license.

In response to argument (6), Examiner respectfully disagrees. Nutter et al. teaches using said score for each of said modules to calculate a total score for each of the entered opportunity. See figure 13 and paragraphs 0019, 0022, 0025-8, 0031, 0039, wherein a score is input for each module and the scores are combined by a computer using weights to compute a total score.

9. Applicant's arguments with regards to Nutter et al. (U.S. 2002/0178029) in view of Elliott (U.S. 2001/0042034) have been fully considered, but they are not persuasive. In the remarks, Applicant argues that Nutter et al. in view of Elliott does not teach or suggest (7) a marketability module and using the module to determine a module score (claim 4), (8) a predetermined weighting factor linked to each of said modules using the user-specified variables or a market, cost, and efficiency module (claim 19), and that (9) the examiner has provided no reason, including any teaching or suggesting, as to why Elliott should be combined with Nutter et al.

In response to argument (7), Examiner respectfully disagrees. Nutter et al. teaches a plurality of licensing and market factors (See paragraphs 0019, 0021, 0026, 0028, 0030-1, 0034). Elliott discloses value drivers relating to ownership of the entered opportunity (See paragraphs 0020-2. Therefore, Nutter et al. in view of Elliott do teach and suggest the limitation, as claimed.

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In response to argument (8), Examiner respectfully disagrees. First, the argument regarding predetermined weighting factor linked to each of said modules using the user-specified variables is addressed above with regards to at least argument (2). Further, Nutter et al. discloses a market module having a plurality of value drivers relating to the marketability of the entered opportunity in at least figure 7 and paragraphs 0028-32 and 0034, where the market of the opportunity is considered in the evaluation. Nutter et al. also discloses an efficiency module having a plurality of value drivers relating to efficiency of the entered opportunity when it discloses ease of investigation, strength of claims, all of which are directed towards the effectiveness of the opportunity. See also figure 13 and paragraph 0030. Finally, Nutter et al. teaches an impact module having a plurality of value drivers relating to overall impact of the entered opportunity on the licensee product and licensee customers. See paragraph 0034, which discloses considering the impact of the license on the products of the customer using the license.

In response to argument (9), Examiner respectfully disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Nutter et al. and Elliott disclose evaluating IP (a licensing opportunity or the IP itself) using factors related to the IP. Since Nutter et al. is concerned with more efficiently evaluating intellectual properties and eliminating intellectual properties that do not score as well as others based on the same

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evaluation factors (See paragraph 0019, 0026), there is teaching and suggestion to combine the references.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eder (U.S. 2004/0215495), Eder (U.S. 6,321,205), and Eder (U.S. 2001/0041995) disclose business value drivers, opportunities that exist within a firm, and using weights to value the opportunities.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is 571-272-6737. The examiner can normally be reached on M-F, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*bvd*  
bvd

June 22, 2007

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